

### **REMARKS**

Claims 1-8, 10 and 12 are pending in the instant application. Claims 8 and 10 have been amended and claim 13 has been added to this application. Please enter the following amendment before reconsideration on the merits.

Claims 1 and 12 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over application Serial No. 09/447,226. Applicants alert the Examiner that application Serial No. 09/447,226 has now been allowed and the issue fee paid. Both the instant application and application Serial No. 09/447,226 are owned in their entirety by Abbott Laboratories. Therefore, in accordance with 37 U.S.C. § 1.130 and § 1.321(c), Applicants hereby disclaim the terminal part of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of the patent granted from application Serial No. 09/447,226. A terminal disclaimer accompanies this Response and Amendment B.

Claims 8 and 10 have been rejected under 35 U.S.C. § 112, first paragraph. The Examiner maintains that claim 8 and 10 contain subject matter which is not enabled. Specifically, the Examiner maintains that the Applicants have improperly extrapolated from the *in vitro* data that compounds of this invention could be used as therapies for various diseases. Applicants respectfully traverse this rejection and request withdrawal of the same.

While Applicants disagree with the Examiner's logic, Applicants have made the amendments to claims 8 and 10 that the Examiner recommended purely in effort to advance prosecution and allowance. The Applicants have removed "pharmaceutical" from claim 8 as the Examiner suggested. However, rather than canceling claim 10, as the Examiner suggested, the Applicants have amended claim 10 to reflect the first claim that the Examiner stipulated would be enabled and allowable (on page 3 of the Office Action).


In addition, the Applicants have added new claim 13. This claim is the second claim that the Examiner stipulated would be enabled and allowable (on page 3 of the Office Action).

### **Action Requested**

Applicants submit that claims 1-8, 10, 12 and 13 are in condition for allowance and request early notification to this effect. Should one or more issues remain unresolved, Applicants request a personal or telephonic interview to discuss these issues with the Examiner.

Respectfully submitted,  
Henkin, et al.

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